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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,394	12/10/2001	Yi Li	PF187DICI	8404

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HUMAN GENOME SCIENCES INC
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,394

Applicant(s)

LI ET AL.

Examiner

Michael Brannock

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Application: Claims and Amendments

Applicant is notified that the amendments put forth on 12/22/04, have been entered in full.

Response to Amendment

Applicant is notified that any outstanding objection or rejection that is not expressly maintained in this Office action has been withdrawn in view of Applicant's amendments.

Maintained Rejections:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-28 stand rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility as set forth previously and reiterated below.

Claims 21-28 are directed to a polypeptide of SEQ ID NO: 2. The instant specification puts forth that the polypeptide is useful in a screening method to determine what ligands may activate or inhibit the polypeptide and also to determine what the physiological effects of the polypeptide might be (see page 4). This proposed use lacks a specific and substantial utility. It

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is not a specific use because any integral membrane protein could be used in exactly the same way. Further, many polynucleotides are known in the art to encode polypeptides, yet the polypeptides have no known function or known ligands. Any of these orphan clones could be used in the manner described in the specification for the claimed polynucleotide.

Furthermore, the proposed use of the polypeptide to screen for ligands of the polypeptide or for biologic effects of the polypeptide is not a substantial utility. A substantial utility is a practical use which amounts to more than a starting point for further research and investigation and does not require or constitute carrying out further research to identify or reasonably confirm what the practical use might ultimately be. For example, an assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would be a practical use of the material. However, a method of treating an unspecified disease or condition with a material that has no particular correlation with a disease would not constitute a substantial utility. Basic research, such as studying the properties of the claimed product or the mechanisms in which the product is involved, does not constitute a substantial utility.

The specification puts forth that compounds that bind to and activate or inhibit the polypeptide of SEQ ID NO: 2 are useful in the prevention and/or treatment of a variety of diseases including upper respiratory conditions, hypertension and myocardial diseases (see pages 4 and 5). A stated belief that a correlation exists between the polypeptides and any number of diseases is not sufficient guidance to use the claimed polynucleotides to treat and/or diagnosis a particular disease; it merely defines a starting point for further research and investigation.

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The instant application has failed to provide guidance as to how one of skill in the art could use the claimed invention in a way that constitutes a specific or substantial utility. The proposed uses of the claimed invention are simply starting points for further research and investigation into potential practical uses of the claimed nucleic acids.

Additionally, claim 28 does not require that the polypeptide be isolated and therefore reads on a protein present in a human body and therefore encompasses non-statutory subject matter.

Applicant argues that not every integral membrane protein could be used the exactly the same way in which the instant polypeptide can be used because there are differences between types of integral membrane proteins. This argument has been fully considered but not deemed persuasive. All integral membrane proteins can be used to find compounds that bind to them or inhibit their functions, whether or not they have a catalytic domain as asserted by Applicant, absent evidence to the contrary.

Applicant argues that the polypeptide is a member of the GPCR family of proteins and that it shows homology to a known adrenergic receptor. These facts are not disputed and the argument has been fully considered but not deemed persuasive. The issue is that the specification fails to assert that the instant polypeptide is an adrenergic receptor or any other particular receptor.

Applicant argues that the specification asserts that the polypeptide is involved in a variety of disease states and that antibody antagonists are taught in the specification; also that the PTO has no reason to doubt these assertions.

This argument has been fully considered but not deemed persuasive. A stated belief that a correlation exists between the polypeptides and any number of disparate diseases is not sufficient guidance to use the claimed polynucleotides to treat and/or diagnosis a particular disease; it merely defines a starting point for further research and investigation. That the polypeptide might ultimately be found to be involved in a particular disease is not disputed.

Applicant's arguments regarding adrenergic receptors have been fully considered but not deemed persuasive. The specification does not assert that the polypeptide is an adrenergic receptor.

Applicant argues that the specification need not prove that a correlation exists between a particular activity and a therapeutic use. This argument has been fully considered but not deemed persuasive. The issue is that the specification has failed to make an assertion of a particular activity or a particular therapeutic use. Applicant's amendment has obviated the bases of the rejection applied to claim 28 as being non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-28 are also rejected under 35 U.S.C. § 112 first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a

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well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention so that it would operate as intended without undue experimentation as set forth previously.

Applicants' arguments regarding the 35 U.S.C. § 112 rejection as the corollary of the 35 U.S.C. § 101 rejection have been addressed above.

Conclusion

No claims are allowable.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX months.

Please note the new central fax number for official correspondence below:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-

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0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached at (571) 272-0829. Official papers filed by fax should be directed to 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Elizabeth C. Hemmner

MB

W

March 21, 2005

ELIZABETH HEMMNER
PRIMARY EXAMINER